## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )  **MAIL STOP AMENDMENT**

Jean-Sebastien Coron )  Group Art Unit: 2135

Application No.: 09/937,397 )  Examiner: NIRIV B PATEL

Filed: April 1, 2002 )  Confirmation No.: 9400

For: COUNTERMEASURE METHOD IN
AN ELETRIC COMPONENT
IMPLEMENTING AN ELLIPTICAL
CURVE TYPE PUBLIC KEY
CRYPTOGRAPHY ALGORITHM

### RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated September 30, 2005, Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims.

Claims 1-15 were rejected on the grounds of obviousness-type double patenting in view of claims 1-7 of U.S. Patent No. 6,914,986. The Office Action contends that the only difference between the pending claims and those of the issued patent is the recitation of "determining a security parameter s". The Action goes on to allege that it would have been obvious to determine a security parameter for the algorithm. Applicant respectfully traverses this ground of rejection, for two reasons.

First, the Office Action has not provided any support for the allegation of obviousness. As set forth in MPEP § 2143, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." This section of the Manual goes on to state, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success *must* both be found in the prior art, not in applicant's disclosure." (emphasis added). The Office Action does not meet this requirement. It does not cite any reference, nor otherwise provide any evidence, that the purported obviousness is known in the prior art. It merely sets forth a conclusion without identifying